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MINNEAPOLIS, MN 55440-1022				
EXAMINER				
BELLINGER, JASON R				
ART UNIT		PAPER NUMBER		
3617				
NOTIFICATION DATE		DELIVERY MODE		
12/17/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary

Application No.

10/574,977

Applicant(s)

MURAKAMI ET AL.

Examiner

Jason R. Bellinger

Art Unit

3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Priority

1. The Applicant's claim of foreign priority to US application 10/683,269 is improper. First, the instant application is a 371 of PCT/JP04/14732 filed 10/6/04. This PCT claimed priority to US application 10/683,269 filed 10/14/03. However, the Applicant did not properly restate the priority claim while entering the national phase in the US under 35 U.S.C. 371, due to the fact that application 10/683,269 was not listed in an Application Data Sheet or before the first line of the specification within 4 months of the first notice received under 35 U.S.C. 371 (37 CFR 1.78). Furthermore, foreign priority claims must be made in an oath/declaration or in an application data sheet no later than 4 months (37 CFR 1.55).

Second, a foreign priority claim to US 10/683,269 under 35 U.S.C. 199 cannot be made, given the fact that application 10/683,269 is not foreign to the US (i.e. the application was filed in the US and is thus a US application). A domestic claim of priority to application 10/683,269 may be made; however, since the time period of 4 months has passed, the Applicant would need to properly reference 10/683,269 either in an application data sheet or by amending the first line of the specification AND file a petition for an unintentionally delayed priority claim under 37 CFR 1.78.

Third, at this time, since appropriate reference to 10/683,269 was not made within the specified time limit in 37 CFR 1.78, priority to the above application is presumed to be waived. Therefore, the Applicant does not receive priority back to the filing date of 10/683,269, and this application qualifies as prior art.

2. The foreign priority claim filed on 7 April 2006 was not entered because the foreign priority claim was not filed during the time period set forth in 37 CFR 1.55(a)(1). For applications that have entered national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and the Regulations under the PCT. See 37 CFR 1.55(a)(1)(ii). If applicant desires priority under 35 U.S.C. 119(a)-(d), (f) or 365(a) based upon a prior foreign application, applicant must file a petition for an unintentionally delayed priority claim (37 CFR 1.55(c)). The petition must be accompanied by (1) the claim (i.e., the claim required by 35 U.S.C. 119(a)-(d) and (f) and 37 CFR 1.55) for priority to the prior foreign application, unless previously submitted; (2) a surcharge under 37 CFR 1.17(t); and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Drawings

3. The drawings were received on 7 July 2008. These drawings are approved.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "114b" and "115b" and "115c" and "116b" have both been

used to designate the same elements, respectively. The reference characters cannot share the same leader line, especially if the reference characters are meant to describe different elements of the invention.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the first, second, and third rings having diameters d_1 , d_2 , and d_3 , respectively, wherein the relationship of the diameters is $d_1 < d_2 < d_3$, as set forth in claim 3, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing

should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to because the text "d1<d2<d3" should be removed from Figure 2. Simply adding this text does not remedy the deficiency set forth in section 5 above. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the

renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

7. The abstract of the disclosure is objected to because of the reasons set forth below. Correction is required. See MPEP § 608.01(b).
8. The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.
9. The disclosure is objected to because of the following informalities: Reference to a claim of priority to Application 10/683,629 (which is an unrelated application) or Application 10/683,269 should be removed from the specification. See sections 1-2 above. Furthermore, the petitions filed 7/7/08 and 8/15/08 relating to this priority claim have been dismissed.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 1-7 rejected under 35 U.S.C. 102(e) as being clearly anticipated by Murakami et al.

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Murakami et al discloses all of the limitations set forth in the claims.

Response to Arguments

12. Applicant's arguments filed 7 July 2008 and 15 August 2008 have been fully considered but they are not persuasive. The Applicant argues that the priority claim to application 10/683,269 is proper. However, both petitions regarding this priority claim have been dismissed (see Petition decisions dated 7/30/08 and 11/7/08).

The Applicant argues that reference characters 114b, 115b and 115c, 116b, respectively, are clearly not referring to the same element. However, section 4 above explains the reasons why this argument is not persuasive.

The Applicant argues that the subject matter of claim 3 is now clearly shown in the drawings. However, this is not the case. Simply adding the text "d1<d2<d3" is insufficient to clearly show the relationship between the diameters of the three sections. The drawings must clearly show each section having a different diameter.

The Applicant argues that the rejection under 35 USC 102(e) does not specify a patent number for the Murakami reference, and "conclude" that reference 2007/0126285 is being referred to by the rejection. First, it should be noted that reference 2007/0126285 is the corresponding US Publication of the *instant application*, and thus is not prior art. Second, given the fact that only one of the cited references is listed as Murakami et al (namely reference 2005/0077093), it is clear that the *cited* Murakami et al reference was used in the rejection.

Given the dismissal of the petitions (as noted above), the Murakami et al (2005/0077093) reference stills qualifies as a prior art reference.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason R. Bellinger whose telephone number is 571-272-6680. The examiner can normally be reached on Mon - Thurs (9:00-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Morano can be reached on 571-272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason R Bellinger/
Primary Examiner
Art Unit 3617